

Application No.: 09/884,549
Response to OA of 03/21/06

Remarks

In the present response, twelve claims (1, 5, 6-9, 11-13, 15, 17-18) are amended. Claims 1-3, 5-15, and 17-20 are presented for examination. No new matter is added.

Applicant thanks Examiner Kumar for issuing a non-final Office Action. With these amendments and remarks, Applicant makes a sincere effort to place this application in condition for allowance.

Claim Rejections: 35 USC § 103(a)

Claims 1-3, 5-15, and 17-20 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,330,976 (Dymetman) in view of USPN 5,680,636 (Levine). This rejection is traversed.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. For at least the following reasons, Applicant asserts that the rejection does not satisfy these criteria.

No Suggestion/Motivation to Modify/Combine References

For at least the following reasons, no suggestion or motivation exists to modify or combine Dymetman in view of Levine.

First, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Dymetman is directed to marking a physical medium (such as paper) with machine-readable markings. These markings encode an identifier that produces an action through a network (see Abstract). Dymetman never mentions or even suggests that the physical medium can be an electronic writing tablet. **By contrast, Levine teaches a completely different invention.** Levine teaches "an electronic stylus and electronic tablet which emulate a pencil and desk pad of paper used by the common businessperson" (1: 54-56). The stylus and tablet are connected to a computer screen for displaying strokes input

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from the stylus (1: 57-60). Levine never mentions or even suggests that another physical medium (such as paper) can somehow be the electronic tablet.

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Dymetman, the Background section discusses problems associated with accessing hyperlinks that are written on paper. For example, when a user sees a hyperlink written on paper, the user must then type the link into a computer (2: 48-65). Alternatively, the user can scan the paper and use optical character recognition to extract the hyperlink (1: 30-38). **By contrast, Levine solves completely different problems.** In Levine, the Background section discusses problems with displaying information using computer menus. As such, most computer devices require a user to be computer literate and learn commands to instruct the computer (1: 29-31). A device that emulates a pencil and pad of paper is much more user friendly (1: 54-56).

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

In light of the completely different inventions and problems being solved in Dymetman and Levine, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicant respectfully asks the Examiner to withdraw the rejection since a *prima facie* case of obvious has not been established.

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Response to Examiner's Arguments on Combination

The Examiner argues that the combination of Dymetman and Levine are obvious because Levine provides Dymetman with electronic tablets, and such "electronic tablets are user friendly and facilitate ease in changing document without being computer savvy as disclosed by Levine col. 1, lines 45-48" (see OA at p. 2). Applicant respectfully disagrees.

First, the system in Dymetman is not at all computer friendly as discussed in Levine. In Dymetman, a user clicks on paper and interacts with special menus that appear on a screen (example, see 29: 1-9). Levine actually **teaches away** from the complex menu driven computer systems of Dymetman ("The present invention introduces a computer device which is a degree 'friendlier' than the menu drive computer devices of today." See 1: 52-54).

Second, Dymetman discusses in great detail definitions and examples for "documents" and "marking medium" and others (see columns 7 and 8 for very well-defined terms used in Dymetman). In spite of such careful and thorough definitions and examples, Dymetman never teaches or even suggests that the physical medium or marking medium can be an electronic tablet.

As discussed above, Dymetman and Levine are directed to different inventions that solve different problems in the art. No motivation exists to combine these references. Instead, the Examiner is performing an improper piecemeal construction that uses hindsight to arrive at the claim elements. In other words, the Examiner is picking and choosing sentences or teachings from Dymetman and Levine with hindsight of Applicant's invention to allegedly obviate the pending claims. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

All Elements Not Taught or Suggested

All of the elements of the claims are not taught or suggested in Dymetman and Levine. In other words, evening assuming *arguendo* that Dymetman and Levine are successfully combinable (which they are not), the alleged combination does not teach or suggest all the elements in the claims.

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Claim 1

Claim 1 recites numerous limitations that are not taught or suggested in Dymetman and Levine. For example, claim 1 recites an electronic tablet that has predefined regions “that receive handwritten mnemonic notations that are hints for different Internet data addresses.” Nowhere does Dymetman teach or suggest such recitations. In Dymetman at column 26, lines 21-29, the user uses a pencil “to make a note to herself on the page.” Dymetman never suggests that this note is a handwritten “mnemonic” note. Dymetman also never suggests that this note is a “hint” for an internet address.

For at least these reasons, claim 1 is allowable over the art of record. The dependent claims are allowable for at least these reasons.

Claim 5

Claim 5 recites numerous limitations that are not taught or suggested in Dymetman and Levine. For example, claim 5 recites accessing an internet site and then associating a “handwritten mnemonic hint” with the internet site. Again, in Dymetman, the user uses a pencil “to make a note to herself on the page.” Dymetman never suggests that this note is a handwritten “mnemonic” note. Dymetman also never suggests that this note is a “hint” for an internet address.

For at least these reasons, claim 5 is allowable over the art of record. The dependent claims are allowable for at least these reasons.

Claim 8

Claim 8 recites numerous limitations that are not taught or suggested in Dymetman and Levine. For example, claim 8 recites writing a mnemonic object on a computer writing tablet. This mnemonic object “is a user recognizable hint” for an internet address. In Dymetman, the user uses a pencil “to make a note to herself on the page.” Dymetman never suggests that this note is a handwritten “mnemonic” note. Dymetman also never suggests that this note is a “user recognizable hint” for an internet address.

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For at least these reasons, claim 17 is allowable over the art of record. The dependent claims are allowable for at least these reasons.

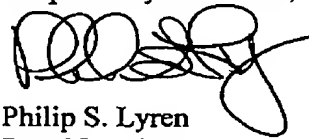
CONCLUSION

In view of the above, Applicant believes all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (832) 236-5529. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 14th day of June, 2006.

By

Name: Carrie McKerley

